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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/631,312 | 07/31/2003 | Ralph Tomonelli | 9539-000089 | 1879 |
| 27572 | 7590 | 05/07/2004 | EXAMINER | |
| HARNES, DICKEY & PIERCE, P.L.C. | | | BINDA, GREGORY JOHN | |
| P.O. BOX 828 | | | ART UNIT | |
| BLOOMFIELD HILLS, MI 48303 | | | PAPER NUMBER | |
| | | | 3679 | |

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,312

Applicant(s)TOMONELLI, RALPH CB**Examiner**

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20030731.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's arguments with regard to the election requirement are persuasive. As such Groups I & II (claims 1-13) as identified in the election requirement mailed March 12, 2004 will be considered a single group.
2. Applicant's election without traverse of a propshaft assembly in the response mailed March 24, 2004 is acknowledged.
3. Claims 14-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the response mailed March 24, 2004.

Drawings

4. The replacement drawings received on March 24, 2004 are approved.

Specification

5. The disclosure is objected to because in paragraph 0023 the word "complementary" is misspelled.
6. The specification is objected to as failing to comply with 37 CFR 1.71 and 1.75(d)(1) because the detailed description fails to provide proper antecedent basis for the subject matter of claims 2 & 8.

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- a. Applicant argues in the response filed March 24, 2004 that the subject matter is shown in Figs. 4 & 5. However, the objection is to the specification for shortcomings in the specification, not in the drawings. If the drawings failed to show the claimed subject matter then that failure would be noted in objection(s) to the drawings.
- b. Applicant argues in the response filed March 24, 2004 that the subject matter is described in paragraphs 24, 25, 30 & 31. However, there does not appear to be any mention of the subject matter there.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4, 6-8, 10, 11 & 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Saurman et al, US 1,769,967 (Saurman). Fig. I shows a propshaft assembly comprising: a shaft structure 4 having a hollow cavity; and an insert member 2 disposed within the hollow cavity and engaging the shaft structure. Fig. II shows the insert member 2 has first and second overlapping slots 3 that extend less than the length of the insert member from the front and rear ends of the insert 2 and are circumferentially spaced apart by a bridging member.

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9. Claims 1, 2, 6, 7, 8 & 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima et al, US 6,409,606. Fig. 6 shows a propshaft assembly comprising: a shaft structure 10 having a hollow cavity; and an insert member 20C disposed within the hollow cavity and engaging the shaft 10. Fig. 5 shows the insert member 20C has first and second overlapping slots 23 that extend from the front and rear ends of the shaft 10 and are circumferentially spaced apart by a bridging member.

10. Claims 1, 2, 4, 6-8, 10, 11 & 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagemeister et al, US 4,626,002. Fig. 1 shows a propshaft assembly comprising: a shaft structure 3, 3' having a hollow cavity; and an insert member 10 disposed within the hollow cavity and engaging the shaft. Fig. 14 shows the insert member 10D has first and second overlapping slots 20D that extend less than the length of the insert member from the front and rear ends of the insert 10D and are circumferentially spaced apart by a bridging member.

11. Claims 1, 2, 4-8 & 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Houghton, US 2,998,269. Fig. 1 shows a propshaft assembly comprising: a shaft structure 13, having a hollow cavity; and an insert member 20 disposed within the hollow cavity and engaging the shaft. Fig. 5 shows the insert member 20 has first and second overlapping slots 24 that extend about five-eighths of the length of the insert member from the front and rear ends of the insert 20 and are circumferentially spaced apart by a bridging member.

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12. Claims 1, 2, 4, 6-8, 10, 11 & 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any one of Wier, US 4,712,811; Berg, US 4,323,727; Sparling, US 1,377,101; Crescio, US 1,448,953; and Hahn, US 987,296.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saurman. Saurman shows all the limitations of the claims except Saurman does not expressly disclose making the length of the insert member 2 about twenty times the length of the gap distance between the slots 3. However, it has generally been recognized that the optimization of proportions in a prior art device is a design consideration requiring only routine skill in the art. *In re Reese*, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the proportion of the gap distance to be one twentieth of the insert length, as such practice is a design consideration within the skill of the art.

15. Claims 3 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the prior art references cited in items 9-12 above for the same reasons noted in item 14.

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Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dake and Brown show slotted insert members.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda
Primary Examiner
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